

## **REMARKS/ARGUMENTS**

Reconsideration of this application, in view of the foregoing amendment and the following remarks and arguments, is respectfully requested.

Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 are currently pending in this application. By the foregoing amendment, Claims 5, 8, 10 and 15 have been revised. Accordingly, Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 remain in this application for consideration and allowance.

The claims currently pending in this application currently stand rejected on the following grounds which are respectfully traversed for reasons subsequently set forth herein.

1. Claims 10, 15, 84 and 91-97 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent 6,478,091 to Gano in view of U.S. Patent 4,683,944 to Curlett;
2. Claim 87 stands rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 6,227,303 to Jones;
3. Claim 88 stands rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett and Jones, further in view of U.S. Patent 5,392,862 to Swearingen;
4. Claim 89 stands rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 6,505,682 to Brockman;
5. Claim 5 stands rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, Brockman and Jones;
6. Claim 6 stands rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, Brockman and Jones, further in view of Swearingen;

7. Claims 8 and 90 stand rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 3,099,318 to Miller et al; and

8. Claim 85 stands rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 3,712,373 to Bearden et al.

The Examiner's obviousness rejections of all of the applicants' pending Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 is premised at least in part on his contention that it would be obvious to utilize teachings of Curlett to reposition the Gano line 83 (shown in FIGS. 5A and 5B of Gano) from between the inner and outer tubular members 54,74 to within the sidewall of the inner tubular member 74 in view of the teachings of Curlett.

It is respectfully submitted that for at least the following reasons it would not be obvious to make the Gano/Curlett reference combination being proposed by the Examiner.

Neither Gano nor Curlett discloses or in any manner suggests the embedding of a line in the sidewall of an innermost one of a plurality of telescoped well screen members as specified in applicants' pending claims 5, 6, 8, 10, 15, 84, 85 and 87-97. As the Examiner acknowledges, Gano positions the line 83 (FIGS. 5A and 5B in Gano) **between** the outer and inner tubular members 64,74. In FIG. 25 of Curlett referred to by the Examiner, the casing 366 is neither a well screen member nor an innermost one of a plurality of telescoped well screen members, the well screen portion of the casing structure 366 shown in FIG. 24 of Curlett being the circular screen 408 disposed on the bottom of the casing structure.

Thus, there is no teaching or suggestion in Curlett's FIG. 25 of disposing a line in the sidewall of the innermost one of a plurality of telescoped well screen members as recited in applicants' Claims 5, 6, 8, 10, 15, 84, 85 and 87-97. Similarly, there is no teaching or suggestion in

Curlett's FIG. 19, also referred to by the Examiner, of this claimed embedment of a line in the sidewall of the innermost one of a plurality of telescoped well screen members.

In fact, Curlett, in conjunction with his FIG. 19 crossover structure, specifically teaches away from the placement of the lines 12 within the sidewall material of the innermost tubular conduit portion 318 of the crossover structure 286. Notice that such lines 112 are disposed entirely outside of this innermost conduit 318 (which, of course, is not a sand screen element).

Even if Curlett did at least hint at the possibility of embedding a line in the sidewall material of an innermost one of a plurality of telescoped well screen members as claimed by the present applicants, Gano teaches specifically away from doing so. As clearly illustrated and described in Gano, the line 83 is snapped into one of the resilient structures 62 to facilitate the external connection of the line 83 to the innermost tubular member 74. The ability to simply snap the line 83 externally onto the tubular member 74 before it is placed into the outer tubular member 64 would be prevented if, as the Examiner proposes, the line 83 was somehow to be embedded in the sidewall material of the innermost tubular member 74.

If this Examiner-proposed modification of the Gano structure in FIGS. 5A and 5B were effected, the specifically described external line attachment advantage disclosed in Gano would be entirely eliminated. It is elementary that if a proposed modification of apparatus disclosed in a reference eliminates or lessens a desirable characteristic of such apparatus, such modification is not an obvious one and an Examiner cannot permissibly do so simply to ostensibly meet the limitations of an applicant's claims.

It is thus respectfully submitted that for at least the foregoing reasons it would not be obvious to combine the Gano and Curlett references as proposed by the Examiner. The Examiner has therefore failed to establish a *prima facie* case of obviousness of applicants' Claims 5, 6, 8, 10, 15, 84, 85 and 87-97, and his obviousness rejections of such claims should accordingly be withdrawn as impermissible.

In view of the foregoing remarks and arguments, all of the claims currently pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 is therefore earnestly solicited.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/516-0030 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,

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on July 26, 2004  
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